Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARBARA A. CHAPPELL, TERRY I. CHAPPELL,
SANG H. DHONG, and MARK S. MILSHTEIN

Appeal No. 1998-2982
Application No. 08/582,716

ON BRIEF[1]

Before KRASS, LALL, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-7, 10, and 11, which are all the claims remaining in the application.

We reverse.

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[1] Appellants waived an oral hearing; see facsimile communication filed February 1, 2001 (Paper No. 17).

BACKGROUND

The invention is directed to an incrementer circuit. Claim 1 is reproduced below.

1. An incrementing circuit comprising:

an input latch for receiving a pulsed input data and outputting a static complement of the pulsed input data, the pulsed input data representing a number to be incremented;

a carry-lookahead circuit, coupled to receive said static complement of the pulsed input data, said carry-lookahead circuit for generating a carry signal from the number to be incremented; and

a summing circuit coupled to receive the carry signals from the carry-lookahead circuit and the pulsed input data representing the number to be incremented, said summing circuit for summing said carry signals and said pulsed input data and producing a pulsed output representing a sum.

The examiner relies on the following references:

Renfro et al. (Renfro)	5,345,110	Sep. 6, 1994
Jagini	5,384,724	Jan. 24, 1995

Claims 1-7, 10, and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Jagini and Renfro.

We refer to the Final Rejection (Paper No. 7) and the Examiner's Answer (Paper No. 12) for a statement of the examiner's position and to the Brief (Paper No. 11) and the Reply Brief (Paper No. 13) for appellants' position with respect to the claims which stand rejected.

OPINION

At the outset, we note that the examiner has withdrawn a reference (an IBM Technical Disclosure Bulletin) that was used in an earlier section 103 rejection. (See Answer, page 2.) The references of Jagini and Renfro thus constitute the evidence that is before us in support of the rejection under 35 U.S.C. § 103.

We agree with appellants that the examiner has failed to set forth a prima facie case of unpatentability. The statement of the rejection (Answer, page 3) alleges that Jagini discloses "all the claimed features" of the claims but for the "input latch" (claim 1) or "converting the pulsed electrical signal" (claim 11). Aside from the fact that the specific requirements of independent claims 1 and 11 that are additional to the "input latch" or the "converting" are not pointed out in Jagini, there is no showing of motivation in the prior art for combining the "latch circuit" of Renfro with the circuitry of Jagini.

We accept the apparent premise that latch circuits were well known to the artisan. However, that all the elements in a combination were known does not, without more, show obviousness of the subject matter. A combination may be patentable whether composed of elements all new, partly new, or all old. Rosemount, Inc. v. Beckman Instruments, Inc., 727 F.2d 1540, 1546, 221 USPQ 1, 7 (Fed. Cir. 1984). Prior art references in combination do not make an invention obvious unless something in the prior art would suggest the advantage to be derived from combining their teachings. In re Sernaker, 702 F.2d 989, 995-96, 217 USPQ 1, 6-7 (Fed. Cir. 1983). Our reviewing court requires

rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., In re Dembiczak, 175 F.3d 994, 998-99, 50 USPQ2d 1614, 1616-17 (Fed. Cir. 1999).

Further, we agree with appellants' observations on pages 2 and 3 of the Reply Brief in answer to the examiner's commentary on page 4 of the Answer. Simply proposing use of a latch as a memory element in the Jagini device does not speak to the specific requirements of independent claims 1 and 11.

The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. § § 102 and 103. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing In re Warner, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). The one who bears the initial burden of presenting a prima facie case of unpatentability is the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). That burden has not been met in the instant case. Accordingly, we do not sustain the rejection of claims 1-7, 10, and 11 under 35 U.S.C. § 103 as being unpatentable over Jagini and Renfro.

CONCLUSION

The rejection of claims 1-7, 10, and 11 is reversed.

REVERSED

ERROL A. KRASS	)	
Administrative Patent Judge	)	
	)	
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	)	BOARD OF PATENT
PARSHOTAM S. LALL	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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HOWARD B. BLANKENSHIP	)	
Administrative Patent Judge	)	

ROBERT P TASSINARI JR
INTELLECTUAL PROPERTY LAW DEPT
IBM CORPORATION
PO BOX 218
YORKTOWN HEIGHTS , NY 10598